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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/383,318 08/26/99 BELGHUITH

K 6004.200-US

EXAMINER

HM12/0418

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SLOBODYANSKY, E

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

04/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/383,318

Applicant(s)
Belghuith et al.

Examiner
Elizabeth Slobodyansky

Group Art Unit
1652



☒ Responsive to communication(s) filed on Apr 17, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13, 15-17, and 22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13, 15-17, and 22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

The response filed April 17, 2001 has been entered.

The Declaration by Dr. Samir Bejar filed April 17, 2001 has been entered.

Claims 13, 15-17 and 22 are pending.

Oath/Declaration

The spelling of the first inventor's name in the Declaration is different from the spelling thereof in the publications.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The full name of Dr. Karima Srih-Belguith has not been set forth correctly. The last name is spelled out as "Belghuith".

Claim Rejections - 35 USC § 102

Claims 13 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Belghith-Srih.

The rejection is maintained for the reasons of record.

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Claims 13, 15-17 and 22 rejected under 35 U.S.C. 102(b) as being anticipated by Belghith et al.

The rejection is maintained for the reasons of record.

Claim Rejections - 35 USC § 103

Claims 15-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belghith-Srih.

The rejection is maintained for the reasons of record.

Response to Arguments

Applicant's arguments filed April 17, 2001 have been fully considered but they are not persuasive.

In their Remarks as well as in the Declaration by Dr. Samir Bejar Applicants confirm that *Streptomyces* sp. SK has become publicly available on February 1, 1999.

The nucleotide sequence of GenBank accession Y15518 that is 100% identical to SEQ ID NO:1 of the instant invention has become publicly available on February 1, 1999 as well.

February 1, 1999 is prior to a filing date of both the instant application (August 26, 1999) and the prior foreign application (May 26, 1999).

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Applicants argue that "Belguith et al. does not teach or suggest the claimed invention because the disclosure of an isolated nucleic acid, without any sequence information, does not provide an artisan with the reasonable expectation of obtaining the claimed DNA sequences when no information is provided about where such DNA sequence could be obtained or isolated from" (page 2, penultimate paragraph, emphasis added). However, in the instant case the information is provided about where such DNA sequence could be obtained or isolated from. The source was known and publicly available prior to the filing date of both the instant application and the prior foreign application. Belghith et al. describe the DNA from the same source, with the same restriction map, encoding an enzyme with the same properties and having the same name as the enzyme and the encoding DNA of the instant invention. The DNA sequences are inherent to the disclosed clone. Mere sequencing of the clone does not impart the patentability to the nucleotide sequences thereof.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, reading "E. Slobodyansky". The signature is written in black ink and is positioned above the printed name and title of the examiner.

Elizabeth Slobodyansky, PhD
Primary Examiner

April 17, 2001